

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3,11, 14, 22, 25, 32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 3,11, 14, 22, 25, 32, these claims refer to a home area network that is located “approximately adjacent” to a customer premises. It is not clear to the examiner, or from the specification, what the specific definition of “approximately adjacent” means.

For prior art consideration, “approximately adjacent” will be given a plain dictionary meaning of “adjacent to”.

For claim 34, See MPEP 2173.05(p) Claim Directed to Product-By- Process or Product and Process

*“A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process.”* In the instant case, the product is presumably “a medium” having encoded instructions as defined by the method steps i.e., the process. However, when considering the claim wholly, it not clear whether the

claim pertains to the product or the process. Therefore, claim 34 is an improper product-by-process claim.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 34 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 34 directed to “a signal” embedded in “a medium”. However, the medium could be construed as a carrier wave (see applicant’s specification, paragraph 00043), and the signal as data, albeit, functional descriptive material (see MPEP 2106.01 (I) for definition) as later defined as “encoded instructions” executed by a computer. Nevertheless, the probability of the medium being a carrier wave renders the claim wholly nonstatutory. See 35 USC 101 Interim Guideline, Annex IV (c). “...it does not appear a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101[.]”

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**(e) the invention was described in-**

**(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English.**

6. Claims 1-2, 4-7, 12-13, 15-18, 23-24, 26-28 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosser, US Patent # 6446261 B1.

With regard to Claim 1, Rosser discloses:

A home area network (Fig. 1 – it is noted by the examiner that the applicant defines a home area network as consumer electronic devices connected together by electronic cable in paragraph 0006 of the disclosure) comprising a plurality of rendering devices (Figure 1, item 56) and a profile application, a method for updating a device profile (Claim 1 – Rosser claims the means “local to the user for automatically creating a continuously updated version of a viewer profile”) adapted for use in a targeted advertisement system, the method comprising:

identifying a rendering device that is active from among the plurality of rendering devices (Column 3, lines 49-53; Rosser teaches a “viewer usage monitor” which records a profile of “viewing habits”. In order to view a program, the rendering device must be active)

determining content-related information associated with a program rendered on the active rendering device; (column 3, lines 53-57; Rosser teaches a device to gather a number of information related items associated with the content)

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updating a profile associated with the active rendering device responsive to the identifying and determining steps (column 3, lines 53-57; Rosser teaches a "rolling viewing profile" which constantly updates based on the viewers viewing habits) wherein the updating step is carried out by the profile application (column 3, lines 49-51; Rosser discloses a "viewer usage recorder" that continuously updates a profile)

With regard to claim 2, Rosser discloses:

The method of claim 1 wherein the home area network is located wholly on the customer premises side of a demarcation point marking a separation from a carrier network (Figure 1; There is a clear separation between item 42 (the customer reception device), and item 40 (the central studio transmission device))

With regard to claim 4, Rosser discloses:

The method of claim 1 wherein the updating step is additionally responsive to the amount of time the program is rendered on the device (column 3, line 53-57; Rosser states that one of the viewing habits used to update a user profile is "duration of that viewing")

Claim 5 is rejected based on the claim 4 rejection. This claim is not distinct from claim 4.

With regard to claim 6, Rosser discloses:

The method of claim 1 further comprising:

Identifying a user viewing the program on the active rendering device; and updating the profile additionally responsive to the identified user (column 15, lines 6-9; Rosser

discloses an embodiment where the profile is related to the specific user based on a viewer access key, or other form of identification)

With regard to claim 7, Rosser discloses:

The method of claim 1 further comprising:

Receiving a user-entered program-control command; and

Updating the profile additionally responsive to the received user-entered program-control command; and

Updating the profile additionally responsive to the received user-entered program-control command (column 11 – lines 30-39; Rosser teaches here a number of user entered program control commands including the adjusting of parameters including, but not limited to “volume, brightness, contrast, etc, and other viewer usage choices”)

Claims 12-13, and 15-18 are the apparatus to perform the method of Claims 1-2 and 4-7, and are rejected on this basis.

Claims 23-24, and 26-28 are the computer program to implement the profile method of claims 1-2, and 4-6, and are rejected on this basis.

Claim 34 is a signal embedded on a computer readable medium to perform the method of claim 23, and is rejected on this basis.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (***See MPEP Ch. 2141***)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

8. Claims 8-10, 19-21, 29-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Rosser” in view of “Markman et al, US PG Pub # 20030122966”.

With regard to Claim 8, as stated above (claim 1 rejection), Rosser teaches:

A home area network comprising a plurality of rendering devices and a profile application, a method for updating device profiles adapted for use in a targeted advertisement system, the method comprising:

Identifying a first rendering device that is active from among the plurality of rendering devices; determining first content-related information associated with a first program rendered on the first active rendering device;

Updating a first profile responsive to the step of identifying the first rendering device and the step of determining first content-related information

However, Rosser fails to teach the following feature:

Identifying a second rendering device that is active from among the plurality of rendering devices;

during rendering of the first program on the first on the first active rendering device,  
determining second-content related information associated with a second program  
rendered on the second rendering device;  
updating a second profile responsive to the step of identifying the second rendering  
device and the step of determining second content-related information

Markman, in his patent application discloses the use of a single STB that  
provides functionality to multiple TVs (Fig. 3 and paragraph 0045).

It would have been obvious to one of ordinary skill in the art at the time of the  
invention was made to combine these two references in order to invent a single  
device that provides the ability to monitor a plurality of devices at the same time.  
The advantage of this would be to reduce hardware cost associated with multiple  
STBs.

Claim 9 is rejected based on the Claim 8 rejection. It would have been  
obvious and expected that the profiles will differ if two different rendering devices are  
being monitored.

Claim 10 is rejected based on the Claim 8 and Claim 2 rejection.

Claims 19-21 are the apparatus to perform method claims 8-10, and are  
rejected on this basis.

Claims 29-31 are the computer readable medium to perform method claims 8-  
10, and are rejected on this basis.

With regard to claim 33, as stated in the Claim 1 rejection, Rosser teaches:

A home area comprising a plurality of rendering devices and a profile application, an apparatus for updating a device profile adapted for use in a targeted advertisement system, the apparatus comprising:

identifying a rendering device that is active from among the plurality of rendering devices

determining content-related information associated with a program rendered on the active rendering device;

updating a profile associated with the active rendering device responsive to the identifying and determining steps

However, Rosser fails to teach the feature of a “media server”.

Markman, in his disclosure, teaches the use of a “media center” that is connected to the external network, and serves the programming and profiles of the client set-top boxes. (Fig. 3 and paragraph 0045)

A person of ordinary skill, at the time of the invention, would find it obvious to combine these two references in order to invent a single device that provides the ability to monitor a plurality of devices at the same time, and serve various forms of data to the individual client devices. The advantage of this would be to reduce hardware cost associated with multiple STBs.

### **Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK D. FEATHERSTONE whose telephone



number is (571)270-3750. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F US Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

e-signed

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